UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,375	03/29/2004	Mark N. Harris	F-780	7607

919 7590 09/22/2006

PITNEY BOWES INC.
35 WATERVIEW DRIVE
P.O. BOX 3000
MSC 26-22
SHELTON, CT 06484-8000

EXAMINER	
VY, HUNG T	

ART UNIT	PAPER NUMBER
2163	

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/812,375	HARRIS ET AL.	
	Examiner	Art Unit	
	Hung T. Vy	2163	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *29 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION
Specification

1. The specification has been checked to the extent necessary to determine the presence of possible minor errors. However, the applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 1, line 10, the phrase "said selected record" renders the claim indefinite because it is not clear the "said selected record" on line 10 (second part) is that the same the "said selected record" in begin of line 10. It is not clear what is the "said selected record" presence for in the claim.

With respect to claim 7, the phrase "one or more default values" renders the claim indefinite because it is not clear what is the default values. Is that the default values is the values from the origin values of record data?

Claims 2-8 depend from rejected claim 1 thereby render these dependent claims indefinite.

Claim Rejections - 35 USC 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or

composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 1-8 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter, specifically, the claims are not directed towards the final result that is "useful, tangible and concrete".

(See State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

According to the New Guidelines of October 26, 2005, which states that "A claim limited to a machine or manufacture, which has a practical application, is statutory. In most cases a claim to a specific machine or manufacture will have a practical application. See Alappat, 33 F.3d at 1544, 31 USPQ2d at 1557)... a specific machine to produce a useful, concrete, and tangible result and State Street, 149 F.3d at 1373-74 USPQ2d at 1601-02).

(Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility <http://rs6.net/tn.jsp?t=mdmd7pbab.0.kbg76pbab.p9qiiibab.7440&p=http%3A%2F%2Fwww.uspto.gov%2Fweb%2Foffices%2Fpac%2Fdapp%2Fopla%2Fpreognotice%2Fguidelines101_20051026.pdf>)

Examiner requests Applicant to include in Applicant's claimed limitations (in all the claims) the following:

What is the practical application?

What is the result?

What is final result that is concrete, useful and tangible?

With respect to claim 1, *the method of converting in a file from a first format to a second format* does not produce a useful, concrete and tangible result as set forth in 2106 (IV)(B)(2)(b)(ii), e.g. ***copying*** *said one or more data elements of said field to said new record at a field location for said field set forth in said second data map associated with said selected*

record is not a tangible result because *copy said one or more data elements of said field to said new record at a field location* is not being used in the method *of* ***converting*** *in a file from a first format to a second format* as recited in the preamble (the step produce the result is **copying** data from one place to anther location that is not a converting data as required for claim). The claim invention does not produce a useful because the process does not meet the requirement as recited in the preamble, e.g., ***converting*** *in a file from a first format to a second format.*

Because the "practical application, result, concrete, useful and tangible" limitations are not claimed in Applicant's claims, Examiner believes that the above listed claims are nonstatutory.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1 is rejected under 35 U. S. C. § 102 (e) as being anticipated by Tamboli et al. (U.S. Patent No. 6,792,431).

With respect to claim 1, as best underdressed, Tamboli et al. discloses a method of converting data stored in a file from a first format (native format) to a second format, said file having one or more records, each of said records having one or more fields having one or more data elements, each of said records being associated with a first data map (705) corresponding to

said first format (see column 15, line 55+) and a second data map (806) corresponding to said second format (see column 16, line 10+), the method comprising: (a) accessing a selected record from said file (122), said selected record being one of said one or more records of said file; (b) initializing a new record (802); (c) for each field of said selected record, using said first data map (705) associated with said selected record and said second data map (806) associated with said selected record to determine whether said field is present in said second format (806), and if said field is present in said second format, copying said one or more data elements of said field to said new record (812) at a field location for said field set forth in said second data map (811) associated with said selected record (first native RCD)(see fig. 7-8); and (d) repeating steps (a), (b), and (c) for each of a remaining one or more of said records of said file (see fig. 7-8 and column 15, line 55+ and column 16, line 1+).

With respect to claim 2, Tamboli et al. discloses data stored in one or more additional files, each of said additional files having one or more records each having one or more fields having one or more data elements, each of said records in each said additional file being associated with a first data map (705) corresponding to said first format and a second data map (806) corresponding to said second format (see fig. 12-14).

With respect to claims 5-6, Tamboli et al. discloses wherein step (b) further comprises initializing said new record in a temporarily file (receive)(802), said method further comprising saving said temporary file (802) as a new file (see fig. 8) and overwriting said file with said temporary file with second data record initializing (see fig. 8).

With respect to claim 7, with best understood, Tamboli et al. discloses wherein step (b) said new record has one or more fields, said fields of said new record being initialized with one or more default values (see fig. 12-14).

With respect to claim 8, Tamboli et al. discloses new record (812) being in said second format (see fig. 8).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamboli et al. (U.S. Patent No. 6,792,431) in view of Gupta. (U.S. Patent No. 6,577,158).

With respect to claims 3-4, Tamboli et al. discloses all limitations of claimed invention recited in claim 1 except for issuing a potential data loss warning if a first size of said one or more data element of said field. However, Gupta et al. discloses issuing a potential data loss warning if a first size of said one or more data element of said field (see column 7, line 50+). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify Tamboli et al.'s system by adding the code for detect for overflow the data in order to prevent the data loss when converting the data for the stated purpose has been well known in the art as evidenced by teaching of Gupta (see column 7, line 50+).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung T. Vy whose telephone number is 571-2721954. The examiner can normally be reached on 8.30am - 5.30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571 272 1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Hung T. Vy
Art Unit 2163
September 14, 2006.